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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,538	02/03/2005	Kenji Sunagawa	KUP-6	7543
20/808	7590	08/23/2010		
BROWN & MICHAELS, PC 400 M & T BANK BUILDING 118 NORTH TIOGA ST ITHACA, NY 14850			EXAMINER KAHELIN, MICHAEL WILLIAM	
			ART UNIT 3762	PAPER NUMBER
			NOTIFICATION DATE 08/23/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/523,538

Applicant(s)

SUNAGAWA, KENJI

Examiner

MICHAEL KAHLIN

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. In regards to the third "wherein" clause of page 3, it is unclear whether the claim amendment limits the "information sent from outside" element only or limits the "control unit" element as a whole. For instance, if the control unit outputs the control signal based on electrocardiographic information (and not information sent from the outside), does that mean that the amended language does not apply? If not (*i.e.*, if the control unit must output the signal based on information sent from the outside), it appears that the language drawn to outputting the control signal based on alternative sources of information (*e.g.*, outside information, electrocardiographic information, or a combination of the two) is surplus language. Based on the limitation drawn to the control unit outputting control signals based on information from other pacemakers, the examiner is considering the claim to require the control unit to output the control signal based on information sent from outside, but the claim should be clarified. Furthermore, it is unclear whether the claim is a system claim actually requiring other implanted pacemakers, and if so, how many. As the claim currently positively recites only a single pacemaker, the examiner is considering the claim to require only a single pacemaker

with a control unit capable of receiving information from another implanted pacemaker (or any other source of wireless signals). In other words, it appears that the amended limitations limit only the control unit of the single pacemaker set forth and do not actually set forth an additional pacemaker(s).

4. In regards to the second "wherein" clause of page 4, it is unclear whether the amended language is setting forth a new element, and if not, what existing element this language is meant to further limit. In other words, does this language mean that the cathode electrode additionally comprises a catalyst; does it mean that the electrode is itself a catalyst; or does it mean that no catalyst is present, but the electrode "requires" one for "enhanc[ment]"? The examiner is considering the claim to require either that the electrode is itself a catalyst material or the electrode additionally comprises a catalyst, but the claim should be clarified.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (US 5,411,535, hereinafter "Fujii") in view of Heller (US 6,294,281, hereinafter "Heller"). Fujii discloses the essential features of the claimed invention, including a pacemaker (Fig. 8) having a control unit (122), a heart stimulating means (125 and 135), an electrocardiograph information detecting means (136), a transmitting means

(137); a receiving means (123); and a power unit (139); wherein the pacemaker is capable of implantation with the tip of a catheter and requiring no chest incision (Figs. 9 and 10); wherein the control unit outputs the control signal based on information sent from other pacemakers (105); wherein the control unit includes a stimulation timing determining means and stimulation timing changing means (122 -- the stimulation timing changes with the received signal 105) and changes the stimulation timing when certain conditions are fulfilled (col. 8, lines 32-47 -- when the main unit modifies the pulse pattern). Fujii does not disclose that the power unit is a biological fuel cell that extracts electrons from oxidative reactions of biological fuels composed of an anode and cathode; wherein the anode is coated with immobile layer of mediators and oxidative enzymes for biological fuels, wherein the layer prevents oxygen existing in a biological body from contacting the anode, and a cathode electrode requiring a catalyst coated with a material capable of preventing permeation of reactive substances other than oxygen and allowing permeation of oxygen and hydrogen ions; wherein the fuel cell uses blood or body fluid as an electrolyte solution and utilizes biological fuels and oxygen in the blood or body fluid without the need for a container to contain the electrolyte solution or metabolic product; and wherein the anode and cathode contact the electrolyte solution. Heller teaches a biological fuel cell for use with implantable pacemaker devices (col. 2, lines 60-67) that extracts electrons from oxidative reactions of biological fuels composed of an anode and a cathode (col. 3, line 22 -- the spacer elements are optional); wherein the anode is coated with an immobile layer of mediators (redox polymer layer; cols. 5-9) and oxidative enzymes for biological fuels (cols. 9-12),

wherein the layer prevents oxygen existing in a biological body from contacting the anode (col. 8, line 16; "poly(acrylic) acid"), and a cathode electrode requiring a catalyst (col. 3, lines 44-46 and col. 4, line 29) coated with a material capable of preventing permeation of reactive substances other than oxygen and allowing permeation of oxygen and hydrogen ions (col. 13, lines 21-47 and col. 14, lines 4-18); wherein the fuel cell uses blood or body fluid as an electrolyte solution and utilizes biological fuels and oxygen in the blood or body fluid without the need for a container to contain the electrolyte solution or metabolic product (col. 14, lines 35-43 and Fig. 1); and wherein the anode and cathode contact the electrolyte solution (col. 14, lines 35-43) to provide the predictable results of powering an implantable device without the need for replacing or recharging batteries. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fujii's invention by providing a biological fuel cell for use with implantable devices that extracts electrons from oxidative reactions of biological fuels consisting of an anode and cathode; wherein the anode is coated with immobile layer of mediators and oxidative enzymes for biological fuels, wherein the layer prevents oxygen existing in a biological body from contacting the anode, and a cathode electrode coated with a material capable of preventing permeation of reactive substances other than oxygen and allowing permeation of oxygen and hydrogen ions; wherein the fuel cell uses blood or body fluid as an electrolyte solution and utilizes biological fuels and oxygen in the blood or body fluid; and wherein the anode and cathode contact the electrolyte solution to provide the predictable results of powering an implantable device without the need for replacing or

recharging batteries. Please note that Heller's coating material (poly(acrylic) acid) inherently prevents oxygen existing in a biological body from contacting the anode. See Reichert et al. (US 5,270,128; col. 3, lines 40-65) as evidence of inherency. In the alternative, it is notorious in the fuel cell arts to prevent oxygen from contacting anodes to provide the predictable result of avoiding degradation of the anode material. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Fujii's invention by preventing oxygen from contacting the anode to provide the predictable result of avoiding degradation of the anode material.

Response to Arguments

7. Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection, necessitated by amendment. Please see Figure 5 of Fujii showing multiple implanted pacemakers.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL KAHELIN whose telephone number is (571)272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Niketa Patel can be reached on (571) 272-4156. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Kahelin/
Examiner, Art Unit 3762